

**REMARKS**

The above referenced patent application has been reviewed in light of the Office Action, dated April 28, 2004, in which:

- the Information Disclosure Statement of February 12, 2001 was rejected under 37 C.F.R. § 1.98(a)(2); and
- claims 1-37 are rejected under 35 U.S.C. § 102(e) on Hendricks *et al.* (hereafter, 'Hendricks,' US Patent No. 6,539,548 B1).

Reconsideration of the above referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 3 month(s), including the appropriate fee, is filed herewith.

Claims 1-37 are now pending the above referenced patent application. No claims have been amended, cancelled, or added. No new matter has been entered.

# **1. 37 C.F.R. § 1.98(a)(2)**

## ***1.1. Information Disclosure Statement***

The PTO has rejected the Information Disclosure Statement of February 12, 2001 under 37 C.F.R. § 1.98(a)(2). It is the Applicants understanding that the rejection is procedural and not substantive; therefore, no prosecution history estoppel should result.

The IDS is resubmitted, with the procedural defects corrected, with this response.

## 2. 35 U.S.C. § 102

### 2.1. *Hendricks: Claims 1-37*

The PTO has rejected claims 1-37 under 35 U.S.C. § 102(b) as being anticipated by Hendricks. This rejection by the PTO of these claims is respectfully traversed.

It is well-established that in order to establish a *prima facie* case of anticipation under § 102 of the patent statute, the PTO must provide a single prior art document that alone has every element and every limitation of the claim being rejected. Therefore, if even a single element or limitation is not met by the asserted document, then the PTO has not succeeded in establishing a *prima facie* case.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants begin with claim 1. Claim 1 recites:

1           1. (Original) A method comprising:  
2                 receiving information regarding a plurality of different entertainment programs  
3           and a plurality of different upgraded media features associated with each entertainment  
4           program;  
5                 displaying at a user terminal a list of entertainment programs and, for each  
6           entertainment program, a plurality of different upgraded media features;  
7                 transmitting an entertainment program selection together with one or more  
8           upgraded media feature selections from the displayed plurality to an entertainment  
9           program provider;  
10                receiving the selected entertainment program with the selected upgraded media  
11           features.

It is respectfully asserted that, as just one example of how the text cited by the PTO fails to meet the language of the rejected claims, Hendricks does not show, teach, use, or describe a

plurality of different **upgraded media features** associated with each entertainment program. Hendricks instead shows presenting the user with a **tiered package of channels**. See Hendricks, Fig 25a.

In the Applicants specification, page 6, lines 7 & 8, an “upgraded media feature” is defined as “Upgraded media features included, but are not limited to, a wide variety of audio, video, and interactive effects.” Applicants Fig. 5 provides a graphical example of this. In the Figure there is a program, *e.g.* Titanic, and additional features, *e.g.* surround sound, HDTV, etc., are offered. The “upgraded media feature” is closely associated with an individual program. In contrast, Hendricks offers no additional features, but instead additional programs. These programs are associated, not with individual programs, as the Applicants claim requires, but with entire channels that broadcast a myriad of programs.

As an example, an embodiment of the Applicants’ disclosed subject matter may include selling Titanic with or without surround sound and the right to record it. It is respectfully asserted that Hendricks does not teach selling Titanic with or without surround sound and the right to record it, but instead Hendricks teaches selling the DISH TV Latino package that includes 31 channels.

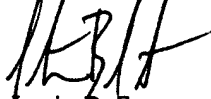
Applicants respectfully contend that Hendricks fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

Claims 2-37 either depend from claim 1, or include a substantially similar and patentably distinct limitation as claim 1. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.

**CONCLUSION**

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,

  
Justin B. Scout  
Reg. No. 54,431

Dated:

Wed Oct 27, 2004

c/o Blakely, Sokoloff, Taylor & Zafman, LLP  
12400 Wilshire Blvd., Seventh Floor  
Los Angeles, CA 90025-1026  
(503) 264-0967

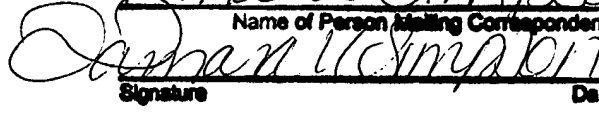
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